Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HIDEHEI KAGEYAMA, SHOUJI ANZAI and YOSHIHIDE MITSUYA

Appeal No. 2001-2361
Application No. 09/411,369

ON BRIEF

Before FRANKFORT, STAAB, and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 3, all of the claims pending in the application.

Appellants' invention relates to a double-chuck mechanical pencil having an adapter (3) combined with the pencil's barrel (1) and lead tank (4) so that the back chuck (5) and front chuck (11) are able to slide axially within the barrel, but are

restrained from rotation relative to the barrel and each other. The pencil also includes an eraser support member provided on a back portion of the adapter. On pages 19-22 of the specification, appellants describe an embodiment of their invention (e.g., Figs. 12-13) wherein the adapter (3) is said to have an "expanded front end portion" (3x) and to include longitudinal ribs (3y) on the outer circumference of said expanded front portion to cooperate with longitudinal grooves (1yy) on the barrel (1) of the pencil, so as to restrain the adapter from rotation relative to the barrel while permitting axial movement thereof relative to the barrel. It would appear that the embodiments of appellants' invention seen in Figures 14 through 17 also include an "expanded front portion" (3x) on the adapters (3) therein similar to that seen in Figures 12 and 13. A primary object of appellants' invention is to prevent the torsional breakage of a lead held by the front and back chucks, particularly when the eraser (E) is being used. A copy of claims 1 through 3 on appeal may be found in Appendix A of appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Torii	4,106,874	Aug. 15, 1978
Swiss Patent	CH 274,269[1]	Jun. 16, 1951

In making a provisional obviousness-type double patenting rejection of claims 1 through 3 in the final rejection (Paper No. 7), the examiner has additionally relied upon appellants' co-pending application No. 09/411,370, filed October 4, 1999.[2]

Claims 1 and 2 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of appellants' co-pending application No. 09/411,370.[3]

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[1] Our understanding of this foreign language document is derived from a translation made by the USPTO. A copy of that translation accompanies this decision.

[2] Appeal No. 2001-2353 in appellants' co-pending application No. 09/411,370 is being decided concurrently herewith.

[3] As indicated on page 2 of the examiner's answer, the provisional double patenting rejection of claim 3 is "vacated upon consideration of applicant's [sic] remarks."

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Torii.

Claim 2 stands rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Torii.

Claim 3 stands rejected under 35 U.S.C. § 103 as being unpatentable over Torii in view of Ch 274,269.

Rather than reiterate the details of the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding those rejections, we refer to the final rejection (Paper No. 7, mailed October 17, 2000), the examiner's answer (Paper No. 12, mailed March 13, 2001) and to appellants' brief (Paper No. 11, filed March 5, 2001) and reply brief (Paper No. 13, filed May 1, 2001) for a full exposition thereof.

OPINION

After careful consideration of appellants' specification and claims, the teachings of the applied references and each of the arguments and comments advanced by appellants and the examiner, we have reached the determinations which follow.

Turning first to the examiner's provisional rejection of claims 1 and 2 under the judicially created doctrine of obviousness-type double patenting, we observe that the examiner has not identified the differences between claims 1 and 2 of the present application and claims 1 through 4 of appellants' co-pending application No. 09/411,370, or provided reasons why any such differences would have been obvious to one of ordinary skill in the art at the time of appellants' invention. Instead, it appears that the examiner has merely asserted that claims 1 and 2 of the present application are not patentably distinct from claims 1 through 4 of the co-pending application, contending that

> the broad limitations in the instant claims encompass the specific limitations of the same structure in the copending application, while the specific limitations in the copending claims anticipate the broad limitations of the same structure in the instant claims. If claim 1 of either application were allowed prior to allowance of the other claim 1, it would

> extend the right to exclude on both elements A and B identified above due to the overlap in scope (final rejection, page 3).

Since the examiner has clearly not established a prima facie case of obviousness-type double patenting, we are constrained to reverse the examiner's rejection of claims 1 and 2 on that basis.

However, given that the examiner's comments above appear to relate to a nonstatutory double patenting rejection of the type made in In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968), we REMAND for the examiner to consider the guidelines set forth in MPEP § 804 (pages 800-26 to 800-28) regarding that type of rejection, and particularly to obtain proper authorization from the Technology Center (TC) Director if such a rejection were to be made in the present application. As an alternative, if the examiner is of the view that the original election requirement was, at least in-part, improper, then the examiner might wish to consider following the guidance in MPEP § 822 and, if appropriate, withdraw the requirement and require the conflicting applications to be joined. If a double patenting rejection is made or reimposed in the present application, the examiner should provide a detailed explanation of why the protections afforded

appellants by 35 U.S.C. § 121 are inapplicable. The examiner's mere assertion that the statute does not prohibit a double patenting rejection where the applications are claiming the same or substantially the same invention is of little value, especially given appellants' arguments in their brief (pages 8-12) and reply brief (pages 2-4).

Looking next to the examiner's rejection of claim 1 under 35 U.S.C. § 102(b) based on Torii, we note that the examiner contends, *inter alia*, that Torii discloses a double-chuck mechanical pencil having a front lead chuck (15) and a back lead chuck (7) connected to a lead tank (8). Appellants argue that the lead holding member (15) of Torii is not a chuck and clearly would not have been recognized as such by one of ordinary skill in the art. We agree with appellants and incorporate herein their arguments set forth in the brief (pages 12-18) and reply brief (pages 4-5) as our own. In that regard, it is clear to us that one of ordinary skill in the art would have understood that a "lead chuck" must actually clamp the lead and hold it in a fixed position during use of the pencil for writing, and that the member (15) of Torii performs no such function. Accordingly, the

examiner's rejection of claim 1 under 35 U.S.C. § 102(b) based on Torii will not be sustained.

Regarding the examiner's rejection of claim 2 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Torii, we share appellants' view as expressed on page 19 of the brief, that Torii does not disclose or teach a mechanical pencil with both a front lead chuck and a back lead chuck, as required in independent claim 1 on appeal, and that the examiner has offered no motivation for modifying the mechanical pencil of Torii to have such a double-chuck arrangement. Accordingly, since claim 2 depends from claim 1, it follows that the examiner's rejection of claim 2 under the alternative grounds noted above will likewise not be sustained.

The last of the examiner's rejections is that of claim 3 under 35 U.S.C. § 103 as being unpatentable over Torii in view of Ch 274,269. In this instance, the examiner contends that it would have been obvious to one of ordinary skill in the art to provide the front end portion of the adapter (10) of Torii with taper portions following the teachings of CH 274,269.

Appellants again point to the deficiency in Torii with regard to claim 1 on appeal and urge that such deficiency is likewise applicable to any determination regarding dependent claim 3. We agree, and for that reason will not sustain the examiner's rejection of claim 3 under 35 U.S.C. § 103 as being unpatentable over Torii in view of Ch 274,269.

In summary:

The examiner's decision rejecting claims 1 and 2 under the judicially created doctrine of obviousness-type double patenting has not been sustained.

The examiner's decision rejecting claim 1 under 35 U.S.C. § 102(b) as being anticipated by Torii has not been sustained.

In addition, the examiner's decision rejecting claim 2 alternatively under 35 U.S.C. § 102(b) and 35 U.S.C. § 103 based on Torii, and claim 3 under 35 U.S.C. § 103 as being unpatentable over Torii in view of CH 274,269 have both been reversed.

Thus, the decision of the examiner rejecting claims 1 through 3 of the present application is reversed.

REVERSED and REMANDED

CHARLES E. FRANKFORT Administrative Patent Judge	)	
LAWRENCE J. STAAB Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JENNIFER D. BAHR Administrative Patent Judge	)	

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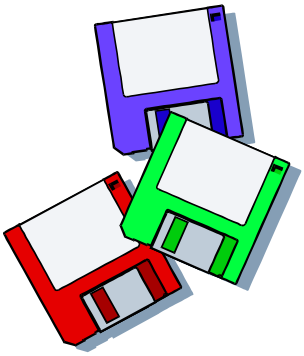

Lesley

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APJ FRANKFORT

APJ STAAB

APJ BAHR

DECISION: REVERSED and REMAND

Prepared: June 5, 2003

Draft Final

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